The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> TEDDY C. JOHNSON
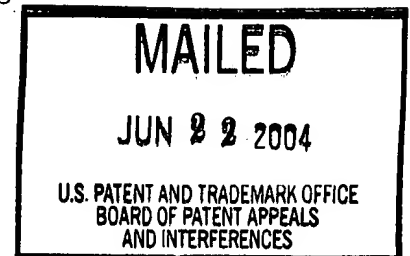
Appeal No. 2003-0073
Application 09/092,488

ON BRIEF

Before THOMAS, JERRY SMITH and GROSS, <u>Administrative Patent Judges</u>.

JERRY SMITH, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-3, 6, 7 and 11. Claims 4 and 5 have been cancelled. Claims 8-10 and 12-19 stand withdrawn from consideration by the examiner as the result of a restriction requirement.

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The disclosed invention pertains to a system for facilitating the transfer of data to authorized users over the Internet.

Representative claim 1 is reproduced as follows:

1. A system for facilitating the transfer of data to authorized users over the Internet, the system comprising:

a plurality of host machines for running a plurality of processes, the plurality of host machines residing on an unsecured side of a firewall, the firewall having a secured side and the unsecured side;

at least one secure communication link between the plurality of host machines;

a filing storage system accessible by at least one of the plurality of host machines, the filing storage system having a storeroom area and a customer account area, wherein the filing storage system supports hard file links between the storeroom area and the customer account area, the hard file links comprising pointers to files;

at least one secured host machine residing on the secured side of the firewall; and

a customer account database located on the secured host machine and accessible by at least one of the plurality of host machines across a second secure communication link through the firewall.

The examiner relies on the following references:

Kawaguchi	5,832,527	Nov. 3, 1998
		(filed Feb. 6, 1996)
Joffe et al. (Joffe)	6,185,619	Feb. 6, 2001
		(filed Nov. 7, 1997)

The admitted prior art described in appellant's specification.

Claims 1-3, 6, 7 and 11 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers the admitted prior art in view of Joffe and Kawaguchi.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 7 and 11. We reach the opposite conclusion with respect to claims 2, 3 and 6. Accordingly, we affirm-in-part.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts

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to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

With respect to independent claims 1 and 11, which stand or fall together [brief, page 5], the examiner finds that the admitted prior art teaches the claimed invention except for the following features:

(1) a plurality of host machines for running a plurality of processes located on an unsecured side of a firewall;

(2) at least one secure communication link between the plurality of host machines;

(3) hard file links comprising pointers to files between the storeroom area and the customer account area; and

(4) at least one secured host machine located on the

secured side of the firewall, wherein the secured host machine

comprises a customer account database which is accessible by at

least one of the plurality of host machines across a second

secure communication link through the firewall. The examiner

addresses each of these differences between the claimed invention

and the admitted prior art by referring to Joffe, Kawaguchi and

well known practices in this art to support the finding of

obviousness [answer, pages 3-6].

Appellant argues that there is no motivation to combine

the references. Specifically, appellant argues that there is no

motivation to combine the teachings of Joffe with the teachings

of Kawaguchi. Appellant also argues that the applied prior art

fails to disclose all the elements of representative claim 1. In

addition to disputing the examiner's findings with respect to

features (1) to (4) above, appellant argues that the prior art

also fails to disclose the following two features:

(5) the filing system having a storeroom area and a

customer account area, wherein the filing storage system supports

hard file links between the storeroom area and the customer area,

the hard file links comprising pointers to files; and

(6) a customer account database located on the secured
host machine and accessible by at least one of the plurality of
host machines across a second secure communication link through
the firewall.

The examiner responds that Joffe provides motivation for
feature (1) above, and Kawaguchi provides motivation for feature
(3) above. The examiner disagrees with appellant's argument that
the applied prior art does not disclose all the features of the
claimed invention [answer, pages 6-10].

Appellant responds that the examiner has shown no
motivation to combine Joffe and Kawaguchi. Appellant also
repeats the argument that there are six features of the claimed
invention not taught by the applied prior art even when combined
[reply brief].

Appellant's argument with respect to the motivation to
combine the references improperly focuses on the combination of
Joffe and Kawaguchi rather than the combination of Joffe with the
admitted prior art and the combination of Kawaguchi with the
admitted prior art. In other words, the examiner has proposed to
add a plurality of host machines to the admitted prior art of
Figure 1 in order to solve the problems of latency and bandwidth
constraints as taught by Joffe. There is motivation to modify

the single host machine of prior art Figure 1 because plural

machines sharing the workload would clearly increase bandwidth as

taught by Joffe. The examiner has also proposed to use hard file

links between the store room and the accounts of Figure 1 as

taught by Kawaguchi in order to attain the improved file

management system as taught by Kawaguchi. Thus, the motivations

to combine proposed by the examiner relate to proposed

modifications of the admitted prior art of Figure 1. We agree

with the examiner that there is motivation for separately

modifying prior art Figure 1 to have the features (1) and (3)

noted above based on the respective separate teachings of Joffe

and Kawaguchi. Appellant's arguments miss the point because they

only address the propriety of combining the teachings of Joffe

with the teachings of Kawaguchi without considering the admitted

prior art. Therefore, this particular argument is not persuasive

of error in the rejection.

With respect to feature (1) per se, appellant simply

asserts that Joffe does not teach this feature as asserted by the

examiner [brief, pages 12-13]. Appellant offers no details in

support of this position. As noted above, the examiner proposes

to replace the host machine 12 of prior art Figure 1 with a

plurality of host machines as taught by Joffe. As also noted

above, we find that there is motivation to make this modification
to Figure 1 because a plurality of computers would clearly
increase the bandwidth of the system of Figure 1. When this
obvious modification is made to Figure 1, the feature identified
as (1) above is taught by the applied prior art. Appellant has
not addressed the examiner's specific rationale for modifying the
structure of the admitted prior art.

With respect to feature (2) per se, the examiner relied
on the fact that a secure communication link would have been
obvious to the artisan because it was well known to use a secure
link to prevent unauthorized access to a computer. Appellant
does not dispute the merits of this finding by the examiner, but
instead, simply argues that the examiner made no particular
findings as required by In re Sang Su Lee, 227 F.3d 1338, 61
USPQ2d 1430 (Fed. Cir. 2002) [brief, page 13].

As noted above, we have found that it would have been
obvious to the artisan to replace the single host computer in
Figure 1 with a plurality of computers to increase bandwidth as
taught by Joffe. With a plurality of host computers present in
Figure 1, the question is whether it would have been obvious to
the artisan to have a secure link between the computers. We
agree with the examiner that broadly speaking, it would have been

obvious to the artisan to secure communications between the two
computers so that data cannot be intercepted by unauthorized
parties. Appellant has provided no rationale as to why the
artisan would not have been motivated to provide secure
communications between a plurality of computers.

With respect to feature (3) per se, appellant simply
argues that Kawaguchi is in no way related to facilitating the
transfer of data over the Internet as claimed [brief, pages 13-
14]. Prior art Figure 1 already shows a filing storage system
having a store room area and a customer accounts area. The
examiner simply proposes to manage this storage system which is
already present in the prior art with a hard file link as taught
by Kawaguchi to improve the file management as taught by
Kawaguchi. The fact that Kawaguchi is not related to the
Internet is not relevant because the admitted prior art of Figure
1 teaches the Internet environment. We agree with the examiner
that the broad use of hard file links in the file management
system of Figure 1 would have been obvious to the artisan in
order to manage the file storage system of Figure 1 more
efficiently as taught by Kawaguchi.

With respect to feature (4) per se, appellant argues that
the examiner's reliance on In re Japikse, 86 USPQ 70 is not well-

founded. Appellant argues that the examiner has not supported his finding that it would have been obvious to the artisan to employ a separate host machine for a customer account database [brief, pages 14-15]. Prior art Figure 1 does not show anything on the internal side of the firewall. There is obviously something on the internal side of the firewall or there would be no reason to have a firewall at all. The company running the website, however, clearly has company and customer information stored on the internal side of the firewall. Any company would have a host computer on this internal side of the firewall for handling data processing which the customers accessing the website are not permitted to access. It is also well known that companies keep customer account databases within their computers. Therefore, we find that the broad recitation in claim 1 of a host machine located on the secured side of the firewall and having a customer account database located there within would have been obvious to the artisan based on conventional customer relationships between a customer and a website. For example, if a customer orders a product from a website, the company would have a host computer on the secured side of the firewall so a customer cannot tamper with the company's computer, and the company would maintain customer account data in this computer

related to products ordered by each customer.

With respect to features (5) and (6), these features have been addressed above. Feature (5) relates to the file storage system having a store room area and a customer area and hard file links. The admitted prior art of Figure 1 shows the filing storage system. Kawaguchi teaches the hard file links. It would have been obvious to the artisan to combine these features for reasons discussed above. Feature (6) relates to a customer account database located on the secured host machine and accessible by one of the plurality of host machines across the firewall. The customer account database located in the secured host machine was discussed above with respect to feature (4). Joffe teaches a plurality of host machines as discussed above with respect to feature (1). The host machine 12 of prior art Figure 1 would clearly communicate with a company computer on the secured side of the firewall. Therefore, all the elements of feature (6) and the interconnection recited in claim 1 would have been obvious to the artisan in view of the applied prior art and the conventional firewall arrangement between a company hosting a website and the customers accessing that website.

In summary, we find that the examiner has established a prima facie case of the obviousness of independent claims 1 and

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11. We have considered each of appellant's arguments in the
briefs related to the rejection of claims 1 and 11, but we are
not persuaded by any of these arguments that the examiner's
rejection of claims 1 and 11 was in error. Therefore, we sustain
the examiner's rejection of claims 1 and 11 for the reasons
discussed above.

With respect to dependent claims 2, 3 and 6, appellant
argues that the examiner has not provided any references to show
the elements of these claims which include the elements of claim
1 [brief, page 17]. The examiner has found that each of these
claims simply recites a well known protocol known to be used for
secure communications. The examiner asserts that appellant has
never seasonably challenged that the use of well known secure
communication protocols, such as DES or tobj, would have been
obvious to the artisan.

We will not sustain the examiner's rejection of claims 2,
3 and 6. Contrary to the examiner's assertion, appellant has
challenged the examiner from the beginning to provide prior art
in support of the obviousness of the protocols recited in claims
2, 3 and 6. Despite appellant's request for prior art to support
the examiner's findings, the examiner has failed to provide this
support. When an applicant challenges the examiner's finding of

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what is well known in the art, and the finding is not susceptible

to immediate confirmation, then the examiner must provide prior

art to support the finding. This record does not support the

examiner's findings in support of the obviousness of claims 2, 3

and 6.

With respect to dependent claim 7, appellant argues that

the examiner has not provided references that disclose the

elements of claim 7 [brief, page 18]. The examiner responds that

the rejection is under 35 U.S.C. § 103 because there is no single

reference which discloses all the elements [answer, pages 9-10].

We will sustain the examiner's rejection of dependent

claim 7. As discussed above, we have determined that it would

have been obvious to the artisan to replace the single host

machine in prior art Figure 1 with a plurality of host machines

as taught by Joffe. The single host machine of Figure 1 is shown

as operating as a web server and an ftp server. In dividing the

operations of the host computer of Figure 1 into a plurality of

host computers to share the data processing, it would have been

obvious to the artisan to divide the major functions of the

single machine shown in figure 1. Therefore, the artisan would

have found it obvious to use one of the plurality of host

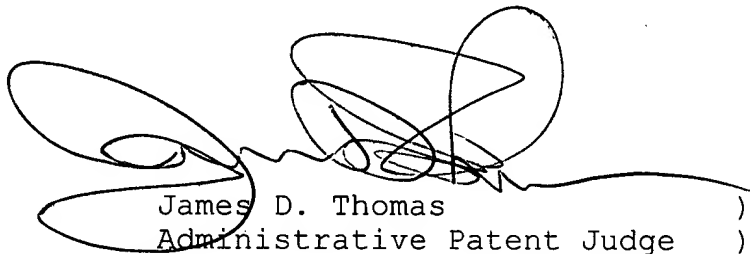machines for running a web server process and another of the host

machines for running an ftp server process to perform the functions of Figure 1 separately.
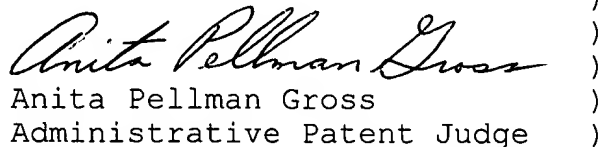
In summary, we have sustained the examiner's rejection of claims 1, 7 and 11, but we have not sustained the examiner's rejection with respect to claims 2, 3 and 6. Therefore, the decision of the examiner rejecting claims 1-3, 6, 7 and 11 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

<u>AFFIRMED-IN-PART</u>

James D. Thomas   )
Administrative Patent Judge   )
)
)
) BOARD OF PATENT
Jerry Smith   )
Administrative Patent Judge   )   APPEALS AND
)
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